UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,207	09/24/2003	Fabio Giannetti	200205657-2	1593

22879 7590 05/20/2008

HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER	
BENGZON, GREG C	
ART UNIT	PAPER NUMBER
2144	

NOTIFICATION DATE	DELIVERY MODE
05/20/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JERRY.SHORMA@HP.COM
mkraft@hp.com
ipa.mail@hp.com

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/668,207
Filing Date: September 24, 2003
Appellant(s): GIANNETTI, FABIO

William T. Ellis, Reg.No. 26874
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 03/14/2008 appealing from the Office action mailed 11/15/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

Claims 1-5, 7,9-16, 19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Slaughter (US Patent 6898618) .

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Slaughter	US Patent 6898618	May 24, 2005
Horvitz	US Patent 6980993	December 27, 2005

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 12-15 pertain to 'a computer-readable medium', which the Applicant Specifications (Page 8 Lines 25-30) define as a carrier wave or data signals embodied in a carrier wave. The Examiner notes that said carrier wave or data signals embodied in a carrier wave are non-statutory subject matter. The Examiner notes that absent

some physical context, a signal per se is an abstract idea in much the same way that a mathematical algorithm without context is an abstract idea.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-5, 7,9-16, 19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Slaughter (US Patent 6898618) .

Slaughter disclosed (re. Claim 1) a method of delivering data to at least one data-handling device, the method comprising the steps of:

storing data that is intended for transmission to the data-handling device according to a predetermined template (Slaughter – Column 15 Lines 65-67) which provides a plurality of fields, each of the fields being capable of containing a portion of the data;(Slaughter-Column 17 Lines 35-45)

storing mappings that map the data within the fields of the predetermined template (Slaughter-Column 87 Lines 55-60) to fields within alternative templates (Slaughter-Column 86 Lines 50-55) should it be determined that the data-handling device is not capable (Slaughter-Column 35 Lines 30-45) of handling data held in the predetermined template; and

transmitting the data to the data-handling device. (Slaughter-Column 17 Lines 35-45)

Claims 9 (device) ,10 (network) ,11-15 (device,medium) , 19-21 (device, network, medium) are rejected on the same basis as Claim 1.

Slaughter disclosed (re. Claim 2) a plurality of predetermined templates in any one of which data may be stored. (Slaughter-Column 86 Lines 50-55)

Slaughter disclosed (re. Claim 3) a plurality of alternative templates (Slaughter-Column 86 Lines 50-55) such that data provided in any of the predetermined templates can be mapped to at least one of the alternative templates. (Slaughter-Column 87 Lines 55-60)

Slaughter disclosed (re. Claim 4) specifying a plurality of mappings from the predetermined to the alternative templates. (Slaughter-Column 86 Lines 50-55)

Slaughter disclosed (re. Claim 5) wherein at least one mapping allows data to be mapped to an alternative template such that the data can be handled by substantially all data-handling devices that may be sent data. (Slaughter-Column 86 Lines 50-60)

Slaughter disclosed (re. Claim 7) determining whether the data-handling device is capable of handling data before transmission to the data-handling device and mapping the data using the mappings should it be determined that the data-handling device cannot handle the predetermined template. (Slaughter-Column 35 Lines 30-45)

Slaughter disclosed (re. Claims 9,10) a receiving means for receiving a request for data, a transmitting means arranged to transmit data, (Slaughter-Column 13 Lines 50-55) a processing means arranged to process data and a storage means for storing data, (Slaughter-Column 13 Lines 50-55) the receiving means is arranged to communicate the receipt of a request for data to the processing means which is arranged, upon the receipt of such a communication, to retrieve data from the storage means which has been stored according to a predetermined template (Slaughter – Column 15 Lines 65-67) which provides a plurality of fields such that each of the fields is capable of containing a portion of the data, (Slaughter-Column 17 Lines 35-45) the storage means also being arranged to store mappings which are arranged to map data held in fields of the predetermined template (Slaughter-Column 87 Lines 55-60) to fields within alternative templates, (Slaughter-Column 86 Lines 50-55) the processing means being capable of mapping data stored in the predetermined template to alternative templates according to the mappings and sending the mapped data to the transmitting means for transmission.

Slaughter disclosed (re. Claims 11) a data-handling device being arranged to communicate a parameter such that the method of claim 1 can be applied to the data that is sent to the data-handling device. (Slaughter-Column 35 Lines 30-45)

Slaughter disclosed (re. Claim 16) a method of delivering data to at least one data-handling device, the method comprising the steps of: i. storing data that is intended for transmission to the data-handling device in one of a plurality of predetermined templates (Slaughter – Column 15 Lines 65-67) each of which provides a plurality of fields and each of the fields being capable of containing a portion of the data; (Slaughter-Column 17 Lines 35-45)ii. providing a plurality of mappings that map data held within a field of one of the predetermined templates (Slaughter-Column 87 Lines 55-60) to fields within an alternative template should it be determined that the data-handling device to which the data is to be sent is not capable of handling data held in the predetermined template; iii. altering the data according to one of the mappings should it be determined that the data-handling device cannot handle the data; (Slaughter-Column 35 Lines 30-45) and iv. transmitting the data to the data-handling device.

Slaughter disclosed (re. Claim 19) a receiver, a transmitter, a processor and a memory, the receiver is arranged to communicate the receipt of a request for data (Slaughter – Column 15 Lines 65-67) to the processor which is arranged, upon the receipt of such a request, to retrieve data from the memory which has been stored in the memory in one of a plurality of predetermined templates (Slaughter-Column 87 Lines 55-60) each of which provides a plurality of fields such that each of the fields is capable of containing a portion of the data, (Slaughter-Column 17 Lines 35-45) the memory also being arranged to store mappings which are arranged to map data held in

fields of the predetermined template to fields within alternative templates, (Slaughter-Column 86 Lines 50-55) the processor being capable of mapping data stored in the predetermined template to alternative templates according to the mappings (Slaughter-Column 87 Lines 55-60) and sending the mapped data to the transmitter for transmission.

Slaughter disclosed (re. Claim 20) a receiver, a transmitter, a processor and a memory, the receiver is arranged to communicate the receipt of a request for data (Slaughter – Column 15 Lines 65-67) to the processor which is arranged, upon the receipt of such a request, to retrieve data from the memory which has been stored according to one of a plurality of predetermined templates (Slaughter-Column 87 Lines 55-60) each of which provides a plurality of fields such that each of the fields is capable of containing a portion of the data, (Slaughter-Column 17 Lines 35-45) the memory also being arranged to store mappings which are arranged to map data held in fields of the predetermined template to fields within alternative templates, (Slaughter-Column 86 Lines 50-55) the processor being capable of mapping data stored in the predetermined template to alternative templates according to the mappings and sending the mapped data to the transmitter for transmission. (Slaughter-Column 87 Lines 55-60)

Slaughter disclosed (re. Claim 21) i. storing data that it is intended to send to the remote device in one of a plurality of predetermined templates (Slaughter-Column 87 Lines 55-60) each of which provides a plurality of fields and each of the fields allowing

a portion of the data to be stored therein; (Slaughter-Column 17 Lines 35-45) ii. providing a plurality of transformations (Slaughter-Column 86 Lines 50-55) that transform data held within one of the plurality of templates such that the data then corresponds to an alternative template such that data held in a field of one of the predetermined templates is moved to a field within the alternative template; iii. transforming the data according to one of the transformations (Slaughter-Column 87 Lines 55-60) should it be determined that the remote device cannot handle the data as it is stored in the predetermined template; iv. and sending the data to the remote device.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 6,8,17,18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slaughter (US Patent 6898618) in view of Horvitz (US Patent 6980993).

Slaughter disclosed (re. Claim 18) i. storing data that is intended for

transmission to the data-handling device in one of a plurality of predetermined templates (Slaughter – Column 15 Lines 65-67) each of which provides a plurality of fields and each of the fields being capable of containing a portion of the data; (Slaughter-Column 17 Lines 35-45) ii. providing a plurality of mappings that map data held within a field of one of the predetermined templates to fields within an alternative template (Slaughter-Column 87 Lines 55-60) should it be determined that the data-handling device to which the data is to be sent is not capable of handling data (Slaughter-Column 35 Lines 30-45) held in the predetermined template iii. altering the data according to one of the mappings should it be determined that the data-handling device cannot handle the data; and iv. transmitting the data to the data-handling device.

While Slaughter substantially disclosed the invention Slaughter did not disclose (re. Claim 18) wherein the predetermined mappings including at least a preferred mapping which is performed in preference to other mappings should it be determined that a mapping is required and a default mapping that is performed if other mappings do not map the data such that it can be handled by the data-handling device;

Horvitz disclosed (re. Claim 18) wherein the predetermined mappings including at least a preferred mapping (Horvitz-Column 37 Lines 30-35) which is performed in preference to other mappings should it be determined that a mapping is required and a default mapping that is performed (Horvitz-Column 54 Lines 15-20) if other mappings do

not map the data such that it can be handled by the data-handling device;

Slaughter and Horvitz are analogous art because they present concepts and practices regarding presentation of content according to specific device capabilities. At the time of the invention it would have been obvious to combine Horvitz into Slaughter. The motivation for said combination would have been to provide a valuable content-sensitive and context-sensitive information service. (Horvitz-Column 2 Lines 10-15)

Slaughter-Horvitz disclosed (re. Claim 6) wherein at least a preferred and an alternative mapping are defined. (Horvitz-Column 37 Lines 30-35)

Slaughter-Horvitz disclosed (re. Claim 17) mappings to be ranked such that at least one of the mappings is performed in preference to at least one of the other mappings. (Horvitz-Column 37 Lines 30-35, Column 38 Lines 15-35,*'preference ordering'*)

While Slaughter substantially disclosed the claimed invention Slaughter did not disclose (re. Claim 8) determining whether the data-handing device is capable of handling the data after it has been transmitted to the data-handling device.

Horvitz disclosed (re. Claim 8) determining whether the data-handing device is capable of handling the data after it has been transmitted to the data-handling device. (Horvitz-Column 25 Lines 15-20)

Slaughter and Horvitz are analogous art because they present concepts and practices regarding presentation of content according to specific device capabilities. At the time of the invention it would have been obvious to combine Horvitz into Slaughter. The motivation for said combination would have been to provide a valuable content-sensitive and context-sensitive information service. (Horvitz-Column 2 Lines 10-15)

(10) Response to Argument

The Examiner maintains the USC 101 rejection because the Applicant Specifications do not exclude transmitted signals as a form of computer-readable medium.

While the Applicant presents a disclaimer regarding the interpretation regarding said computer-readable medium the Examiner notes that the disclaimer is not sufficient to clarify the scope of the claims and overcome the USC 101 rejection because the Applicant Specifications still do not exclude transmitted signals as a form of computer-readable medium.

The Applicant presents the following argument(s) [*in italics*]:

…there is no suggestion or teaching in Slaughter that once a presentation schema is chosen, another could be utilized, and data could be re-mapped. This disclosure of Slaughter instead asserts that a template is predetermined through negotiations between a client and a service. Further, there is no teaching or suggestion of a re-negotiation of a template in Slaughter, let alone remapping of data…

The Examiner respectfully disagrees with the Applicant.

Slaughter disclosed storing content from a service using a space repository (Slaughter-Column 36 Lines 25-35) for XML data. It would have been obvious to a person of ordinary skill in the art that where XML data is concerned there is a corresponding XML schema, and thus Slaughter disclosed *a presentation schema being chosen (by the service)*. (Slaughter-Column 43 Lines 40-55) After the content is stored in the space repository, the client is then provided with a negotiation mechanism, allowing the service to customize the results for the client. (Slaughter-Column 35 Lines 35-40) It would have been obvious to a person of ordinary skill in the art that customizing the XML content would have necessarily involved a re-mapping of data according to a different XML schema, as dictated by the client capabilities.

The Applicant presents the following argument(s) [*in italics*]:

… there is no teaching or suggestion that mappings are stored that map the presentation elements from one schema to elements in another schema. Mapping data to a schema is in no way equivalent to mapping elements of one schema to elements of another schema. Further, mapping data to a schema does not provide any teaching or suggestion that mappings are stored that map data from one schema to another… There is no teaching or suggestion in Slaughter that data is mapped from one presentation schema to another schema.

The Examiner respectfully disagrees with the Applicant.

The Examiner notes that XML schemas inherently involve mapping data according to a specified tag, said data being arranged according to a layout. Thus where Slaughter disclosed storing XML schemas then the storage of mappings is also disclosed.

Slaughter Column 86 Lines 45-65, Column 87 Lines 45-65 disclosed multiple presentation schemas for displaying the same results with different formats. Where the original data is associated with an original schema, then there is an implicit mapping between the original schema and the chosen presentation schema.

The Applicant presents the following argument(s) [*in italics*]:

… Slaughter utilizes this negotiation to create a template for communication, rather than determine if an existing template is sufficient.

The Examiner respectfully disagrees with the Applicant.

The Examiner notes that Slaughter Column 35 Lines 50-65 disclosed a search and match process for interface requirements. Thus Slaughter disclosed *determining if an existing template is sufficient* for communication.

The Applicant is respectfully requested to consider prior art by Lonnroth regarding post-processing for XML response documents.

The Applicant presents the following argument(s) [*in italics*]:

… There is no teaching or disclosure in Horvitz that data is mapped from one schema to another, if the recipient device is unable to handle data in the first schema, or that such mappings are stored. Given the teachings of Horvitz, it is clear that Horvitz does not make up for the deficiencies of Slaughter as shown above.

The Examiner respectfully disagrees with the Applicant.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

Horvitz is relied upon to disclose preferred mappings (Horvitz-Column 37 Lines 30-35, *'rendering preference'*, Column 38 Lines 15-35,*'preference ordering'*) and default mappings.

While Slaughter substantially disclosed the invention Slaughter did not disclose (re. Claim 18) wherein the predetermined mappings including at least a preferred mapping which is performed in preference to other mappings should it be determined that a mapping is required and a default mapping that is performed if other mappings do not map the data such that it can be handled by the data-handling device.

Horvitz disclosed (re. Claim 18) wherein the predetermined mappings including at least a preferred mapping (Horvitz-Column 37 Lines 30-35) which is performed in preference to other mappings should it be determined that a mapping is required and a default mapping that is performed (Horvitz-Column 54 Lines 15-20,*'standard representation'*) if other mappings do not map the data such that it can be handled by the data-handling device.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/G. B./

Examiner, Art Unit 2144

/William C. Vaughn, Jr./

Supervisory Patent Examiner, Art Unit 2144

Conferees:

/William C. Vaughn, Jr./

Supervisory Patent Examiner, Art Unit 2144

/John Follansbee/

Supervisory Patent Examiner, Art Unit 2151